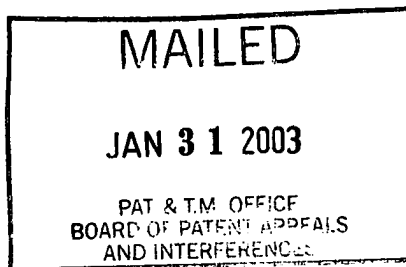




UNITED STATES PATENT AND TRADEMARK OFFICE

DIRECTOR OF THE UNITED STATES PATENT AND TRADEMARK OFFICE
BOARD OF PATENT APPEALS AND INTERFERENCES
BOX INTERFERENCE, WASHINGTON, D.C. 20231

Filed by: Judge Richard Torczon
Telephone: (703) 308-9797
Facsimile: (703) 305-0942



Applicant: McCORMICK
Application No.: 08/724,631
Filed: 10/01/96
For: METHOD FOR PRECIPITATING NUCLEIC
ACID WITH VISIBLE CARRIER
Accorded benefit: 60/004,668, filed 10/02/95

The above-identified application or patent has been forwarded to the Board of Patent Appeals and Interferences because it is adjudged to interfere with another application or patent. An interference has been declared. The interference is designated as No. 105,065.

Notice is hereby given the parties of the requirement of the law for filing in the Patent and Trademark Office a copy of any agreement "in connection with or in contemplation of the termination of the interference." 35 U.S.C. § 135(c).


RICHARD TORCZON
Administrative Patent Judge

BOX INTERFERENCE
WASHINGTON DC 20231
703-308-9797
703-305-0942 (fax)

Paper 1

UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

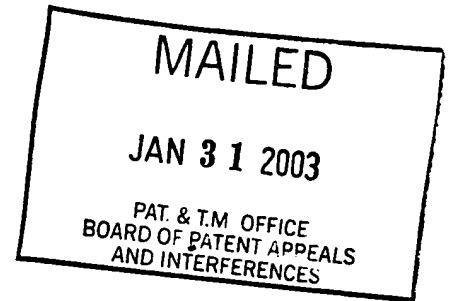
Patent Interference No. 105,065

MITSUGU USUI
MARI YAMAGUCHI, MOTOHITO KANESHIMA, and AKIJI AOKI
(08/817,101),
Junior Party,

v.

MARK R. McCORMICK
(08/724,631),

Senior Party.



NOTICE DECLARING INTERFERENCE
(37 CFR § 1.611)

Part A. Declaration of interference

An interference is declared (35 U.S.C. § 135(a)) between the captioned parties. Details of the applications, count, and claims designated as corresponding to the count appear in Parts E and F of this NOTICE DECLARING INTERFERENCE.

**Part B. Administrative patent judge assigned
to administer the interference**

The interference has been assigned to Richard Torczon. 37 CFR § 1.610.

Part C. Standing order

A Trial Section STANDING ORDER accompanies this NOTICE DECLARING INTERFERENCE. The STANDING ORDER applies to this interference.

Part D. Conference call to set dates

A telephone conference call to set dates for action in this interference is scheduled for **2 p.m. (Eastern) on 27 March 2003.** (The Board will initiate the call.)

No later than **two business days** prior to the conference call, each party shall file and serve by facsimile a list of the preliminary motions the party intends to file. See § 17 of the **STANDING ORDER.**

A copy of a sample order setting times for taking action during the preliminary motion phase of the interference accompanies this NOTICE DECLARING INTERFERENCE. Counsel are encouraged to discuss the order by telephone prior to the telephone conference call and to reach an agreement as to dates for taking action. A typical preliminary motion period lasts approximately nine months. Counsel should be prepared to justify any request for a shorter or longer period.

Electronic filing

The parties should be prepared to discuss electronic filing of papers in the interference. The basic outlines of the program are shown in:

<http://www.uspto.gov/web/offices/dcom/bpai/its/104761-021.pdf>.

Part E. The parties to this interference

Junior Party

Inventors: Mitsugu USUI of Abiko-shi, Chiba-ken,
Mari YAMAGUCHI of Yokohama-shi, Kanagawa-ken,
Motohito KANESHIMA of Toride-shi, Ibaragi-ken, and
Akiji AOKI of Akiruno-shi, Tokyo-to, all of JAPAN

Application: 08/817,101, filed 18 April 1997

Title: Coprecipitant and method for extracting nucleic acids

Priority benefit: PCT/JP96/02263, filed 9 August 1996¹

Assignee: Sanko Junyaku K.K.

Attorneys: See last page

Address: See last page

Senior Party

Inventor: Mark R. McCORMICK of Madison, WISCONSIN

Application: 08/724,631, filed 1 October 1996

Title: Method for precipitating nucleic acid with visible carrier

Priority benefit: 60/004,668, filed 2 October 1995

Assignee: Novagen, Inc.

Attorneys: See last page

Address: See last page

Part F. Count and claims of the parties

Count 1

The method of Usui claim 28 or McCormick claim 13.

¹ Benefit has not been accorded for Usui's Japanese applications because no certified translations of those applications appear in the record. Without certified translations, Usui's claim to benefit cannot be verified.

The claims of the parties are:

Usui: 28, 30-52, and 54-58

McCormick: 1-13 and 16-24

The claims corresponding to Count 1:

Usui: 28, 30-35, 43, and 44

McCormick: 1-13 and 16-24

The claims not corresponding to Count 1:

Usui: 36-42, 45-52, and 54-58²

McCormick: None³

Part G. Heading to be used on papers

Addendum 1 provides the heading that shall be used on all papers filed in the interference. See § 18 of the STANDING ORDER.

Part H. Summary of dates for taking action

Addendum 2 provides a summary of dates and times for taking action set in the STANDING ORDER.

² It is not clear why the examiner did not require restriction of these claims.

³ The examiner attempted to restrict out certain claims as not corresponding (631 Paper 16), apparently to avoid an undue patent term adjustment. McCormick traversed the restriction.

Part I. Order form for requesting file copies

Addendum 3 provides an order form for requesting file copies. Use of the form will expedite the processing of your request.


RICHARD TORCZON
Administrative Patent Judge

Enclosures:

- Copy of STANDING ORDER
- Copy of order used for setting times for taking action in the preliminary motion phase of the interference
- Copy of order used for setting times for taking action in the priority phase of the interference
- Copy of the application claims for: 08/724,631 and 08/817,101

cc (via overnight carrier):

Counsel for Usui (real party-in-interest, Sanko Junyaku K.K.):

David T. Nikaido
ARENT FOX KINTNER PLOTKIN & KAHN PLLC
1050 CONNECTICUT AVE NW STE 600
WASHINGTON DC 20036-5339
Tel: 202-857-6000
Fax: 202-638-4810

Counsel for McCormick (real party-in-interest, Novagen, Inc.):

Bennett J. Berson
QUARLES & BRADY
PO BOX 2113
MADISON WI 53701-2113
Tel: 608-251-5000
Fax: 608-251-9166

ADDENDUM 1

Filed on behalf of: Party _____

Paper No. _____⁴

By: Name of lead counsel
 Name of backup counsel
 Street address
 City, State, and ZIP Code
 Tel:
 Fax:

UNITED STATES PATENT AND TRADEMARK OFFICE

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES
(Administrative Patent Judge Torczon)**

MITSUGU USUI
MARI YAMAGUCHI, MOTOHITO KANESHIMA, and AKIJI AOKI
(08/817,101),
Junior Party,

v.

MARK R. McCORMICK
(08/724,631),

Senior Party.

Patent Interference No. 105,065

TITLE OF PAPER

⁴ Leave blank for the Board to insert the paper number when the paper is entered into the administrative record.

ADDENDUM 2

SUMMARY OF DATES FOR TAKING ACTION

Dates and times for taking action are set in the following sections of the **STANDING ORDER**:

1. **§ 7** - date for identifying lead and backup counsel.
2. **§ 8** - date for identifying any real party in interest.
3. **§ 9** - date for requesting copies of involved and benefit applications and patents.
4. **§ 17** - date for filing list of preliminary motions to be filed.
5. **§ 19** - date for accomplishing certain discovery.
6. **§ 20** - date for filing clean copy of claims.
7. **§ 21** - date for filing clean copy of claims in cases with drawings or claims containing a means-plus-function limitation.
8. **§ 23** - times for filing oppositions to Rule 635 motions and times for filing replies to oppositions.
9. **§ 33** - time for objecting to admissibility of evidence.
10. **§ 34** - time for serving supplemental affidavits or evidence to respond to an objection to admissibility of evidence.
11. **§ 35** - times when cross-examination can take place.
12. **§ 45** - times for taking action with respect to settlement discussions

ADDENDUM 3

FILE COPY REQUEST
Patent Interference No. 105,065

A copy of Part E of this NOTICE DECLARING INTERFERENCE should be attached to this FILE COPY REQUEST, with a hand-drawn circle around the patents and applications for which a copy of a file wrapper is desired.

To facilitate processing of this FILE COPY REQUEST, the following information should be included:

1. Charge fees to USPTO Deposit Account No. _____
2. Complete address, including street, city, state, zip code and telephone number (do not list a Post Office box inasmuch as file copies are sent via commercial overnight courier).

Telephone, including area code: _____